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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,229	03/30/2004	Michael Frederick Kenrich	2222.5490000	8114

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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ABEDIN, SHANTO

ART UNIT	PAPER NUMBER
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2136

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07/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/815,229	KENRICH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shanto M Z Abedin	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 30 March 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. This office action is in response to the communication filed on 03/30/2004.
2. Claim 1-25 are currently presented for the examination.
3. Claim 1-25 have been rejected.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-3 and 9-37 of copending application no. 10/815251.

***Regarding claims 1-12 and 21-25***, they are unpatentable over claims 1-3, 9-11 and 29-37 of the copending application 10/815251 - although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed elements/ features of the instant application exist in claim-set of the copending application in similar or different names, essentially performing same tasks.

***Regarding claims 13-30***, they are unpatentable over claims 1-3 and 9-28 of the copending application 10/815251 - although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed elements/ features of the instant application exist in claim-set of the copending application in similar or different names, essentially performing same tasks.

Difference between the conflicting claims of the instant application and the conflicting claims of the copending application is that the copending application claim set does not recite expressly “document retention policy being based on a recurring cut-off retention schedule”, however, at the time of invention, these limitations would be obvious over the teachings of claims 2, 9-11, 15-16 and 24-27 (document retention policy specifies a document retention period that expires a predetermined period of time after the occurrence of the future event; document retention policy based on document retention period).

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 3-6, 21, 23-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

***Regarding claims 1, 3-6, 21, 23-24,*** the language of the claim(s) raises a question whether the claim is directed merely to an abstract idea which would not result in a practical operation producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. In particular, claim steps such as obtaining or assigning or imposing the retention policy did not result in prevention or deactivation or activation or access permission or storing or encryption or any other practical result that related to the document. MPEP 2106.01 [R-5].

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-25 are rejected under 35 USC 102 (e) as being anticipated by Ryan (US 2005/0071657 A1).

*Regarding claim 1, Ryan* discloses a method of providing automated document retention for electronic documents, said method comprising:

obtaining an electronic document (Par [0027], [0037], [0038]; electronic file/ document);  
assigning a document retention policy to the electronic document, the document retention policy being based on a recurring cut-off retention schedule (Par [0027],[0029], [0037], [0038];[0051]-[0053]; time based access; expiring predetermined retention/ access time); and  
cryptographically imposing the document retention policy on the electronic document (Par [0027], [0029], [0037], [0038]; securing/ encrypting).

*Regarding claim 10, Ryan* discloses a method for periodically providing document retention keys to clients of a document retention system via a network, said method comprising:

determining whether a cut-off period for a current or prior document retention key has been reached (Par [0027],[0029], [0037], [0038];[0051]-[0053]; time based access; expiring predetermined retention/ access time);

generating a next document retention key to be used to encrypt electronic documents during a next cut-off period, the next document retention key having a document retention period associated therewith (Fig 4, 5; Par [0037], [0038];[0051]-[0053]; new time based key; time based access to the document, and time based access key); and

notifying any of the clients that are connected to the network of the next document retention key ([0051]-[0053]).

*Regarding claim 13, Ryan* discloses a method for restricting access to an electronic document, said method comprising:

identifying an electronic document to be secured, the electronic document having at least a data portion that contains data (Fig 7; Par [0027], [0037], [0038]; electronic file/ document);

obtaining a document key (Par [0027], [0037], [0038]; electronic file/ document);

encrypting the data portion of the electronic document using the document key to produce an encrypted data portion (Fig 4, 7; Par [0047]-[0051]; Claims 9-16; encrypting/ securing the document);

obtaining a retention access key, the retention access key being used to enforce a document retention policy on the electronic document (Par [0013], [0017], [0051], [0065]; policy; access key);

encrypting the document key using the retention access key to produce an encrypted document key, the retention access key only being usable for said encrypting during a cut-off period (Par [0047]-[0051]; Claims 9-16);

forming a secured electronic document from at least the encrypted data portion and the encrypted document key (Fig 4, 7; Par [0047]-[0051]; Claims 9-16; encrypted or securing the document); and

storing the secured electronic document (Par [0047]-[0051]; Claims 9-16).

*Regarding claim 16, Ryan* discloses a method for accessing a secured electronic document by a requestor, the secured electronic document having at least a header portion and a data portion, said method comprising:

obtaining a retention access key, the retention access key being used to enforce a document retention period of a document retention policy on the electronic document, the retention access key being usable only during the document retention period following a cut-off period (Par [0027],[0029], [0037], [0038];[0051]-[0053]; time based access; expiring predetermined retention/ access time);

obtaining an encrypted document key from the header portion of the secured electronic document (Fig 4, 7; Par [0047]-[0051]; Claims 9-16; encrypted or securing the document);

decrypting the encrypted document key using the retention access key to produce a document key (Par [0047]-[0052]; Claims 9-16; decrypted document);

decrypting an encrypted data portion of the secured electronic document using the document key to produce a data portion (Par [0047]-[0052]; Claims 9-16); and

supplying the data portion to the requestor (Par [0047]-[0052]; Claims 9-16).

*Regarding claims 21 and 25*, they recite the limitations of claims 10 and 13-20, therefore, they are rejected applying the same rational as applied to reject claims 10 and 13-20.

*Regarding claim 2, Ryan* discloses a method as recited in claim 1, wherein said method further comprises:

subsequently determining whether a document retention period for the electronic document has been exceeded (Par [0016], [0038];[0051]-[0053]; Claims 13, 18, 28; exceeding predetermined time); and

cryptographically preventing access to the electronic document in accordance with the document retention policy when the document retention period for the electronic document has been exceeded (Par [0016], [0038];[0051]-[0053]; Claims 13-18).

*Regarding claim 3, Ryan* discloses a method as recited in claim 1, wherein said imposing operates to utilize a cryptographic key to impose the document retention policy, and wherein the document retention policy specifies a document retention period and a cut-off period (Par [0027], [0037], [0038], [0045], [0051]-[0053]; time based access to the document and key; expiring predetermined retention/ access time).

*Regarding claim 4, Ryan* discloses a method as recited in claim 3, wherein the document retention policy specifies a document retention period that expires a predetermined period of time after the cut-off period (Par [0029], [0037], [0038];[0051]-[0053], [0065]).

*Regarding claim 5, Ryan* discloses a method as recited in claim 3, wherein the cut-off period corresponds to a maximum off-line period of a client ([0037], [0038];[0051]-[0053]).

*Regarding claim 6, Ryan* discloses a method as recited in claim 1, wherein said imposing comprises acquiring a cryptographic key from a server over a network, the cryptographic key

being used to impose the document retention policy (Par [0013], [0017], [0051], [0065]; policy; access key).

***Regarding claim 7, Ryan*** discloses a method as recited in claim 6, wherein said method further comprises:

determining whether the document retention period has expired (Par [0017], [0037]-[0038]; [0051]-[0053]; time based access; expiring predetermined retention/ access time )and deactivating the cryptographic key when said determining determines that the document retention period has expired, thereby preventing further access to the electronic document (Par [0017], [0046], [0051]; Claims 18-23; time based access key).

***Regarding claim 8, Ryan*** discloses a method as recited in claim 7, wherein said imposing operates to utilize a cryptographic key to impose the document retention policy, and wherein the document retention policy specifies a document retention period and a cut-off period (Par [0037], [0045], [0051],[0057], [0060], [0062], [0065]; access restriction to the document and key).

***Regarding claim 17, Ryan*** discloses a method as recited in claim 16, wherein the retention access key is identified by an indicator within a header portion of the secured electronic document (Fig 7; header; file key; Par [0047]-[0053]; Claim 1-16).

***Regarding claim 18, Ryan*** discloses a method as recited in claim 16, wherein the retention access key is a private retention access key (Fig 7; header; file key; Par [0047]-[0053]; Claim 1-16; private/ public key pair).

***Regarding claims 9, 11-12***, they recite the limitations of claims 4-8, therefore, they are rejected applying as above rejecting claims 4-8.

***Regarding claims 14-15 and 19-20***, they recite the limitations of claims 4-6 and 17-18, therefore, they are rejected applying as above rejecting claims 4-6 and 17-18.

***Regarding claims 22-24***, they recite the limitations of claims 2-9, therefore, they are rejected applying as above rejecting claims 2-9.

### ***Conclusion***

7. A shortened statutory period for response to this action is set to expire in 3 (Three) months and 0 (Zero) days from the mailing date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C 133, M.P.E.P 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanto M Z Abedin whose telephone number is 571-272-3551. The examiner can normally be reached on M-F from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser, can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shanto M Z Abedin

Examiner, AU 2136

NASSER MOAZZAMI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

  
7,02,07